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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,329	12/01/2003	Erik E. Emstad	6683.75USU1	3659
43541 7590 12/17/2007 WOOD, HERRON & EVANS (ZIMMER SPINE) 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			EXAMINER SWIGER III, JAMES L	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 12/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/726,329

Applicant(s)

EMSTAD ET AL.

Examiner

James L. Swiger

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/1/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 1 is objected to because of the following informalities:

In line 9, it is suggested that "herein" be amended to state --wherein--.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be "material to patentability as defined in 37 CFR 1.56".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Jacobson (US Patent 4,545,374). Jacobson discloses a spinal device that is capable of allowing access to the appropriate region of the spine, and at least specific pedicle locations. Jacobson discloses an instrument that has a portal member (31) that has an elongated aperture (32), a blade member (18, see also fig. 8) that is positionable along the

aperture of the portal member with a blade-end, and also a placement wire (33) wherein the blade member is capable of moving relative to the wire in use of the device.

It is noted that Jacobson in another interpretation, may be considered to, more specifically, have the blade member be slidably positionable over the placement wire. Depending on how one uses or views the device, the wire in the side of the cannula could be considered "under" the bladed portion depending on how the device is used. In this respect, the blade device could be "slidably positioned" over the placement wire.

The device is also capable of providing access to two pedicle locations due to its elongated shape. Jacobson also has what is considered a stopping structure (36) as it enables two portions at least (wire and portal) to have controlled movement relative to one another. Jacobson also discloses pins (43).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-13, and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson '374 in view of Simonson (US Publication 2003/0083688). Jacobson discloses the claimed invention *supra* except for a layered, nested, incremental portal assembly in the device. Simonson discloses a nested access

cannula that incrementally, and with an elongated shape, provide access to the necessary area of the spine. The nested members also allow the insertion of at least some type of working tool with a blade-like edge (16) so that the structure can provide access to a spinal area requiring surgery. (See also paragraph 0033). Additionally, the nested members are capable of being altered, moved relative to one another, or manipulated as the surgeon chooses to do so. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the surgical instrument of Jacobson having at least a layered, nested, and incremental structure in view of Simonson to better use the device and have access to multiple points in surgery.

Claims 14 -15 rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson '374 and Simonson '688 and Koros et al. (US patent 5,928,139).

The combination of Jacobson and Simonson disclose the claimed invention except for more specifically, a sleeve that has outer portions that create a collar, and a clamping plate to help orient the device. Koros et al. disclose a spinal access device that has a portal member (Fig. 1) that has a collared portion (34) extending from a pivot location (approx 38). Additionally the collared portion disclose a clamp plate (14/18/24/16) that helps to orient the different sleeve sections. These modification allow for optimum placement and maneuverability to access the spinal area desired (Col. 3, lines 25-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of the combination of Jacobson

and Simonson having at least the outer collared portions and a clamping plate in view of Koros et al. to better size and arrange the spinal access instrument as required.

Allowable Subject Matter

The allowability of claims 14-15 has been withdrawn in view of the above reference to Koros et al. See rejections as noted above.

Response to Arguments

Applicant's arguments filed 9/26/2007 have been fully considered but they are not persuasive. Arguments are substantially moot in view of the above changes to the status of the claims. Regarding the placement of the wire and blade, see rejection above for further explanation of how the blade is considered slidably positioned over the wire.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 12/10/07
JLS


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